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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,415	04/24/2001	Michael P. Straub	Verizon-9	5473

32127 7590 12/17/2004

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EXAMINER
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HONG, HARRY S

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/841,415

Applicant(s)

STRAUB ET AL.

Examiner

Harry S. Hong

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-26 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8-11, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Furman (US 5,465,295; cited and applied for the first time).

Refer to column 3, line 59 – column 4, line 46 where Furman teaches detecting a first telephone call to a first telephone number; determining if the first telephone call is a fax or voice telephone call (by looking at the suffix); if the first telephone is a voice telephone call, forwarding the call using a second telephone number; and if the first telephone call is a fax telephone call, forwarding the call using a third telephone number, the third telephone number being different from the second telephone number. The claimed terminating attempt trigger of claim 8 is inherent to Furman since Furman teaches AIN; and the claimed service control point and the peripheral device read on the NCP of Furman. The claimed call forwarding service subscriber record including a fax forwarding telephone number and a voice telephone call forwarding telephone number of claim 14 is clearly depicted in FIG. 2 of Furman.

3. Claims 19, 20 and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Freeman (US 6,020,980; cited and applied for the first time).

The entire patent to Freeman is directed to the claimed method of sending an E-mail message including the received facsimile message to a call forwarding service subscriber (reads on the subscriber taught throughout the disclosure of Freeman). Freeman teaches operating a telephone switch to detect a call to a telephone number (see Switch 116 in FIG. 1); connecting the telephone call to a peripheral device coupled to the telephone switch (the peripheral device reads on the Fax Server 122); and Freeman teaches the claimed functions of the peripheral device. The limitations of claim 20 are clearly shown at column 8, line 29 – column 9, line 2.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 12, 13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furman in view of Freeman.

Furman is silent with respect to forwarding a facsimile to an E-mail address. However, Freeman plainly teaches such a feature and Furman suggest forwarding any call to an E-mail address (see column 1, lines 17 – 20 and lines 43 – 46). Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to incorporate the feature of Freeman into the system of Furman in order to provide an even more enhanced call forwarding service.

8. Claims 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman as applied above.

Freeman does not specifically teach an AIN terminating attempt trigger, however, some type of triggering has to be inherent for the system of Freeman to operate. And, although Freeman teaches conventional PSTN signaling (note that the NCS 118 is equivalent per function to the claimed service control point), AIN SS7 signaling and its advantages are ubiquitous in the present state of the telephony art. Therefore, to incorporate AIN SS7 signaling into the PSTN of Freeman would have been an obvious

Art Unit: 2642

design choice even to one of ordinary skill in the art at the time of the invention. A terminating attempt trigger is an inherent part of AIN SS7.

9. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of McAfee et al. (McAfee; US 6,510,211; cited and applied for the first time).

Freeman as stated above teaches the claimed subscriber record but is silent with respect to a fax forwarding number. McAfee teaches the advantages of fax forwarding with a subscriber record including a field for fax forwarding number (see FIG. 8 of McAfee). Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to incorporate a fax forwarding number into the subscriber record of Freeman in order to forward facsimile calls to other facsimile machines.

#### ***Allowable Subject Matter***

10. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

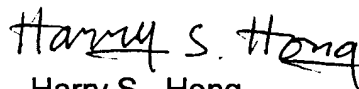
#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weiser and Miller, Jr. et al. teach other aspects of forwarding facsimile to an E-mail address.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (703) 306-3040. The examiner can normally be reached on Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Harry S. Hong  
Primary Examiner  
Art Unit 2642

December 9, 2004